

ESTTA Tracking number: **ESTTA460428**

Filing date: **03/07/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Roots Canada Ltd.
Granted to Date of previous extension	03/07/2012
Address	1400 Castlefield Avenue Toronto, M6B 4C4 CANADA
Attorney information	Joseph R. Dreitler Dreitler True, LLC 137 E. State Street Suite 101 Columbus, OH 43215 UNITED STATES jdreitler@ustrademarklawyer.com, mtrue@ustrademarklawyer.com, ttrofino@ustrademarklawyer.com Phone:614-545-6354

### Applicant Information

Application No	85353128	Publication date	11/08/2011
Opposition Filing Date	03/07/2012	Opposition Period Ends	03/07/2012
Applicant	Luna, Gustavo 945 Brett St. Inglewood, CA 90302 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, hats, jackets, shirts, t-shirts, sweaters, pants, shorts, beanies, polo shirts, short sleeve shirts, long sleeve shirts, v-neck shirts, tank tops, hooded sweatshirts, shoes, and belts
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1815610	Application Date	02/09/1989
Registration Date	01/11/1994	Foreign Priority Date	NONE

Word Mark	ROOTS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: SADDLE SOAP AND SHOE POLISH</p> <p>Class 018. First use: LUGGAGE, HANDBAGS, WALLETS, KEY CASES AND LEATHER KEY FOBS</p> <p>Class 025. First use: FOOTWEAR; NAMELY, SHOES, SLIPPERS, BOOTS, GOLF SHOES, GLOVES, HOSIERY, SCARVES, BELTS, T-SHIRTS, SWEATSHIRTS, CLOTHING OF ALL TYPES; NAMELY, SLACKS, SHIRTS, SOCKS, TIES, SUITS, JACKETS, COATS, DRESSES, BLOUSES, SKIRTS AND JEANS</p> <p>Class 042. First use: RETAIL OUTLET SERVICES FOR SELLING FOOTWEAR; NAMELY, SHOES, SLIPPERS, BOOTS, GOLF SHOES; SHOE ACCESSORIES; NAMELY, SADDLE SOAP AND SHOE POLISH; LUGGAGE, WALLETS, HANDBAGS, KEY CASES AND LEATHER KEY FOBS, SCARVES, BELTS, T-SHIRTS, SWEATSHIRTS, HOSIERY, GLOVES, CLOTHING OF ALL TYPES; NAMELY, SLACKS, SOCKS, TIES, SHIRTS, SKIRTS, JACKETS, COATS, DRESSES, BLOUSES, AND JEANS</p>

Attachments	<p>Roots Canada - Graff Roots - Notice of Opposition (2).pdf ( 7 pages )(111387 bytes )</p> <p>Opp_1815610_CutePDF.pdf ( 2 pages )(123822 bytes )</p> <p>Opp_1815610_AssignmentStatus_CutePDF.pdf ( 2 pages )(95087 bytes )</p>
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Joseph R. Dreitler/
Name	Joseph R. Dreitler
Date	03/07/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF: TRADEMARK APPLICATION NO. 85353128 -- GRAFFROOTS  
DATE OF PUBLICATION: November 8, 2011

**ROOTS CANADA LTD.,**

**Opposer,**

**v.**

**GUSTAVO LUNA,**

**Applicant.**

**Opposition No.:** \_\_\_\_\_

**NOTICE OF OPPOSITION**

Roots Canada Ltd. (hereinafter "Opposer" or "Roots"), a corporation organized under the laws of Canada, having offices at 1400 Castlefield Avenue Toronto, Ontario, Canada M6B 4C4, believes that it will be damaged by the registration of U.S. Serial No. 85/353128 and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. § 1063. As grounds therefor, it is alleged that:

1. Roots and its related companies and affiliates have, since long prior to June 22, 2011, the filing date and constructive use date alleged by Gustavo Luna (hereinafter referred to as "Applicant") for the trademark GRAFFROOTS, for "Clothing, namely, hats, jackets, shirts, t-shirts, sweaters, pants, shorts, beanies, polo shirts, short sleeve shirts, long sleeve shirts, v-neck shirts, tank tops, hooded sweatshirts, shoes, and belts", been engaged in the offering of a wide variety of clothing and other products, under the mark ROOTS. Roots and its various related and affiliated entities shall hereafter be collectively referred to as "Opposer".

2. Roots is a well-known manufacturer, distributor and retailer of clothing, footwear, leather products, personal care products and housewares, among other things, all of which Roots distributes around the world under the ROOTS® trademark. Roots has sold handbags and other related goods under the ROOTS® trademark in the United States since as early as 1995. Roots has promoted and sold shoes under its well-known and famous ROOTS® trademark for 35 years. For over 25 years, Roots has promoted and sold apparel under the ROOTS® trademark. Roots has built a large and successful business in the United States under the ROOTS® trademark. For example, the ROOTS® trademark gained tremendous popularity in the United States when Roots was selected to design the U.S. Olympic team uniforms for the 2002 Winter Olympic Games in Salt Lake City, and also outfitted the U.S. Olympic team in 2004 and 2006. ROOTS® apparel has also been worn by celebrities and featured in films.

3. Roots owns the following U.S. registration for its well-known and famous ROOTS® trademark for a wide variety of leather goods, and for retail outlet services.

Trademark	Status	Goods/Services
ROOTS SN:73-779721 RN:1,815,610	Registered: January 11, 1994	(Int'l Class: 3) Saddle soap and shoe polish (Int'l Class: 18) Luggage, handbags, wallets, key cases and leather key fobs (Int'l Class: 25) Footwear; namely, shoes, slippers, boots, golf shoes, gloves, hosiery, scarves, belts, t-shirts, sweatshirts, clothing of all types; namely, slacks, shirts, socks, ties, suits, jackets, coats, dresses, blouses, skirts and jeans (Int'l Class: 42) Retail outlet services for selling footwear; namely, shoes, slippers, boots, golf shoes; shoe accessories; namely, saddle soap and shoe polish; luggage, wallets, handbags, key cases and leather key fobs, scarves, belts, t-shirts, sweatshirts, hosiery, gloves, clothing of all types; namely, slacks, socks, ties, shirts, skirts, jackets, coats, dresses, blouses, and jeans

A copy of the current printout from the USPTO's TARR database showing the current status and title of this registration (the "Roots Mark") are attached to this Notice of Opposition as Exhibit

A.

4. The certificate of registration identified in paragraph 3 is valid and subsisting and record title is in Opposer; the certificate of registration is prima facie evidence of the validity of the registration, the Registrant's ownership of the mark, and of the Registrant's exclusive right to use the mark in commerce in connection with the goods and services specified in the certificate of registration under the provisions of 15 U.S.C. § 1057(b) and constructive notice of the Registrant's claim of ownership under 15 U.S.C. § 1072. The registration is incontestable, which provides conclusive evidence of its validity under 15 U.S.C. § 1115(b).

5. On June 22, 2011, Applicant filed application Serial Number 85/353128 – GRAFFROOTS – for “Clothing, namely, hats, jackets, shirts, t-shirts, sweaters, pants, shorts, beanies, polo shirts, short sleeve shirts, long sleeve shirts, v-neck shirts, tank tops, hooded sweatshirts, shoes, and belts”.

6. The goods described by Applicant's GRAFFROOTS mark for “Clothing, namely, hats, jackets, shirts, t-shirts, sweaters, pants, shorts, beanies, polo shirts, short sleeve shirts, long sleeve shirts, v-neck shirts, tank tops, hooded sweatshirts, shoes, and belts”, are identical to Opposer's goods offered under its ROOTS mark.

7. Upon information and belief, the goods for which Applicant seeks to register the designation GRAFFROOTS are the same or very similar to the goods Oppose provides under its ROOTS® trademark, and will be offered to the same persons.

8. Upon information and belief, the Applicant's goods will be marketed, promoted and offered through the same marketing channels as are the goods provided by Opposer under its ROOTS® trademark.

9. The designation GRAFFROOTS which the Applicant seeks to register is very similar to Opposer's famous ROOTS mark.

10. The Opposer, since long prior to Applicant's constructive use date of June 22, 2011 for GRAFFROOTS, has spent and continues to spend, large sums of money in the promotion and advertisement of its various goods and service identified and distinguished by its ROOTS mark, and by reason of such promotion and advertising and the high quality of all the products and services carrying the Opposer's trademarks, Opposer now enjoys a valuable goodwill and an enviable and famous reputation with respect to its trademarks and its goods and services.

11. The distinctive trademark ROOTS and other variations owned by Opposer has attained widespread public recognition and acquired great value as an identification of the source of goods and services in or by Opposer for more than thirty-five (35) years of continuous and widespread use on products and services and the expenditure of millions of dollars in advertising and promoting Opposer's ROOTS mark to its customers and potential customers; and the said mark distinguishes Opposer's goods and services from the goods and services of others.

12. The designation GRAFFROOTS which Applicant seeks to register is merely Opposer's mark ROOTS preceded by the term "GRAFF". Because the term "GRAFF" within the designation that has no meaning other than to modify ROOTS, consumers will assume GRAFFROOTS for a wide variety of clothing items are simply a new line of ROOTS clothing. Potential customers who hear "GRAFFROOTS" used in connection with clothing and apparel items that are identical to the types of goods offered by Opposer under its ROOTS mark will think that Applicant and/or its GRAFFROOTS clothing items are connected with or sponsored by Opposer.

13. The use, promotion and registration of GRAFFROOTS by the Applicant, a direct competitor of Opposer, will cause customers throughout the United States to assume, erroneously, and to be confused, misled and/or deceived, that the Applicant's GRAFFROOTS apparel is affiliated with, endorsed or sponsored by Opposer, all to the Opposer's irreparable damage.

14. Opposer's ROOTS® trademark is famous under the Lanham Act.

15. The Application to register GRAFFROOTS was filed after Opposer's ROOTS® trademark became famous.

16. Registration of Applicant's GRAFFROOTS mark will likely dilute the distinctive quality of the ROOTS® trademark because the registration of Applicant's GRAFFROOTS mark will lessen the capacity of Opposer's ROOTS® trademark to identify and distinguish goods and services offered exclusively by Roots.

17. Registration of GRAFFROOTS is likely to dilute the ROOTS® trademark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

18. For the reasons set forth in paragraphs 1 through 17, Opposer believes, and in so believing asserts, that the goodwill in its distinctive ROOTS trademark will be damaged under Section 2(d) and will also be diluted under Section 43 (c), and that the Applicant should be denied the registration of GRAFFROOTS for the goods for which it has filed application Serial No. 85/353128.

19. By reason of the foregoing, Applicant's application of GRAFFROOTS for "Clothing, namely, hats, jackets, shirts, t-shirts, sweaters, pants, shorts, beanies, polo shirts, short sleeve shirts, long sleeve shirts, v-neck shirts, tank tops, hooded sweatshirts, shoes, and belts" is likely to both cause confusion with and dilute Opposer's marks for the same and related goods

and services, and thus is not registrable under Section 13 of the Trademark Act of 1946 (15 U.S.C. § 1063).

WHEREFORE, Opposer prays that this Opposition be sustained and that application Serial No. 85/353128 – GRAFFROOTS - be refused registration.

The fee of \$300.00 as provided by Sections 13 and 31 of the Trademark Act of 1946 is paid by charging Opposer's attorneys' deposit account.

Please recognize Joseph R. Dreitler and Mary R. True, both members of the Bar of the State of Ohio, as its attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications to: Joseph R. Dreitler, c/o Dreitler True LLC, 137 E. State Street, Columbus, Ohio 43215.

Dated: March 7, 2012

Respectfully submitted,



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Joseph R. Dreitler  
Mary R. True  
DREITLER TRUE LLC  
137 E. State Street  
Columbus, Ohio 43215  
Telephone: (614) 545-6354  
Facsimile: (614) 221-2169

Attorneys for Opposer  
Roots Canada Ltd.

Attachment



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and accurate copy of the foregoing Notice of Opposition was served via email First Class U.S. mail this 7th day of March, 2012, upon the following:

Gustavo Luna  
945 Brett St.  
Inglewood, CA 90302

A handwritten signature in black ink, reading "Joseph R. Dreitler". The signature is written in a cursive style with a large, stylized "J" and "D".

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Joseph R. Dreitler

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Mar 7 04:35:47 EST 2012

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# Record 1 out of 1

TARR Status | ASSIGN Status | TDR | TTAB Status

( Use the "Back" button of the Internet Browser to return to TESS)

## Typed Drawing

Word Mark	ROOTS
Goods and Services	IC 003. US 004. G & S: SADDLE SOAP AND SHOE POLISH IC 018. US 003. G & S: LUGGAGE, HANDBAGS, WALLETS, KEY CASES AND LEATHER KEY FOBS IC 025. US 039. G & S: FOOTWEAR; NAMELY, SHOES, SLIPPERS, BOOTS, GOLF SHOES, GLOVES, HOSIERY, SCARVES, BELTS, T-SHIRTS, SWEATSHIRTS, CLOTHING OF ALL TYPES; NAMELY, SLACKS, SHIRTS, SOCKS, TIES, SUITS, JACKETS, COATS, DRESSES, BLOUSES, SKIRTS AND JEANS IC 042. US 101. G & S: RETAIL OUTLET SERVICES FOR SELLING FOOTWEAR; NAMELY, SHOES, SLIPPERS, BOOTS, GOLF SHOES; SHOE ACCESSORIES; NAMELY, SADDLE SOAP AND SHOE POLISH; LUGGAGE, WALLETS, HANDBAGS, KEY CASES AND LEATHER KEY FOBS, SCARVES, BELTS, T-SHIRTS, SWEATSHIRTS, HOSIERY, GLOVES, CLOTHING OF ALL TYPES; NAMELY, SLACKS, SOCKS, TIES, SHIRTS, SKIRTS, JACKETS, COATS, DRESSES, BLOUSES, AND JEANS
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73779721
Filing Date	February 9, 1989
Current Filing Basis	44E
Original Filing Basis	44E
Published for Opposition	April 28, 1992
Registration Number	1815610
Registration Date	January 11, 1994
Owner	(REGISTRANT) ROOTS CANADA LTD. CORPORATION CANADA 1162 CALEDONIA ROAD TORONTO, ONTARIO M6A 2W5 CANADA
Assignment	ASSIGNMENT RECORDED

Recorded	
Attorney of Record	BETH H GOLDMAN
Prior Registrations	0995891
Type of Mark	TRADEMARK. SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040225.
Renewal	1ST RENEWAL 20040225
Other Data	SUBJECT TO CONCURRENT USE PROCEEDING WITH REGISTRATION NO. 1,413,446. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING ALL OF THE UNITED STATES EXCEPT FOR THE STATE OF NEW JERSEY, PURSUANT TO THE OCTOBER 14, 1987 DECREE OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY IN CIVIL ACTION NO. 79-2966, AFFIRMED BY THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT IN APPEAL NO. 87-5776.
Live/Dead Indicator	LIVE

- TESS HOME
- NEW USER
- STRUCTURED
- FREE FORM
- BROWSE Dict
- SEARCH OG
- TOP
- HELP



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## Assignments on the Web > [Trademark Query](#)

### Trademark Assignment Abstract of Title

#### Total Assignments: 3

**Serial #:** [73779721](#)

**Filing Dt:** 02/09/1989

**Reg #:** [1815610](#)

**Reg. Dt:** 01/11/1994

**Registrant:** ROOTS CANADA LTD.

**Mark:** ROOTS

#### Assignment: 1

**Reel/Frame:** [0661/0292](#)

**Received:**

**Recorded:** 07/21/1989

**Pages:** 0

**Conveyance:** ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

**Assignors:** [GREEN, DON](#)

**DBA/AKA/TA:** DBA BRIAN-JOEL

[BUDMAN, MICHAEL](#)

**DBA/AKA/TA:** DBA BRIAN-JOEL

**Assignee:** [ROOTS CANADA LTD.](#)

1162 CALEDONIA ROAD

TORONTO, ONTARIO, NONE

**Exec Dt:** 05/01/1989

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Exec Dt:** 00/00/0000

**Entity Type:** UNKNOWN

**Citizenship:** NONE

**Entity Type:** CORPORATION

**Citizenship:** CANADA

**Correspondent:** ROGERS, BERESKIN & PARR

COMMERCE COURT POSTAL STATION

P.O. BOX 313

TORONTO, CAX M5L -1G1

#### Assignment: 2

**Reel/Frame:** [1664/0574](#)

**Received:** 12/17/1997

**Recorded:** 12/11/1997

**Pages:** 30

**Conveyance:** SECURITY AGREEMENT

**Assignor:** [ROOTS CANADA LTD.](#)

**Exec Dt:** 09/26/1997

**Entity Type:** CORPORATION

**Citizenship:** CANADA

**Assignee:** [CIBC WOOD GUNDY CAPITAL](#)

BCE PLACE, 6TH FLOOR

161 BAY STREET

TORONTO, ONTARIO, CANADA M5J 2S8

**Entity Type:** DIVISION OF THE CANADIAN  
IMPERIAL BANK OF COMMERCE

**Citizenship:** CANADA

**Correspondent:** SHOEMAKER & MATTARE, LTD.

KEVIN G. SMITH, ESQ.

SUITE 1203 - CRYSTAL PLAZA BLDG. 1

2001 JEFFERSON DAVIS HWY.

ARLINGTON, VA 22202

#### Assignment: 3

**Reel/Frame:** [1668/0001](#)

**Received:** 01/05/1998

**Recorded:** 12/12/1997

**Pages:** 29

**Conveyance:** SECURITY AGREEMENT

**Assignor:** [ROOTS CANADA LTD.](#)

**Exec Dt:** 09/26/1997

**Assignee:** [CANADIAN IMPERIAL BANK OF COMMERCE](#)

MANAGING DIRECTOR, DIVERSIFIED INDUSTRIES  
COMMERCE COURT WEST, 7TH FLOOR  
CANADA M51 1A2

**Entity Type:** AN ONTARIO CANADA  
CORPORATION

**Citizenship:** NONE

**Entity Type:** CANADIAN BANK CHARTERED  
UNDER THE FEDERAL BANK ACT

**Citizenship:** NONE

**Correspondent:** SHOEMAKER AND MATTARE, LTD.

KEVIN G. SMITH  
SUITE 1203 - CRYSTAL PLAZA BLDG. 1  
2001 JEFFERSON DAVIS HWY  
ARLINGTON, VA 22202

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.1  
Web interface last modified: Jan 26, 2012 v.2.3.1

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